

U.S. Patent Appln. No. 10/086,391
Amendment Dated June 13, 2005
Reply to Office Action of Mar. 11, 2005
Docket No. BOC9-2001-0012 (247)

REMARKS/ARGUMENTS

These remarks are made in response to the Office Action of March 11, 2005 (Office Action). As this response is timely filed within the three-month shortened statutory period, no fee is believed due.

In paragraph 6 of the Office Action, objections were made due to minor informalities, which have been corrected. Applications respectfully request that these objections now be withdrawn.

In paragraph 8 of the Office Action, claims 1, 5-11, 13, 14, 16, 19, 20, 22 and 23 have been rejected under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent No. 6,026,156 to Epler, *et al.* (Epler) in view of U.S. Patent No. 6,636,506 to Fan (Fan). In paragraph 9, claim 3 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Epler in view of Fan and in further view of U.S. Patent No. 5,559,860 to Mizikovsky (Mizikovsky). In paragraph 10, claims 12, 15, and 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Epler in view of Fan and in further view of U.S. Patent No. 6,108,630 to Kuechler *et al.* (Kuechler) and further in view of U.S. Patent No. 5,930,501 to Neil.

In response, independent claims 1, 7, 14, and 20 have been amended to clarify disclosed aspects of the present invention. More specifically, claims 1, 7, 14, and 20 have been amended to clarify that the claimed participant is a telephone subscriber, as supported by FIG. 1, items 135-160, by page 6, lines 18-25, and throughout the specification. Claims 1, 7, 14, and 20 have also been amended to clarify that the

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subscriber assigns via the interface the call waiting tones that are assigned to the calling parties, as supported by page 8, lines 15-20. Claims 1, 7, 14, and 20 have further been amended to clarify that the subscriber selects the call waiting tones using an Internet connection, as supported by page 10, lines 13-14. No new matter results from these claim amendments.

Before turning to the rejections the art, a brief review of the claimed invention may be helpful. Applicants' claimed invention permits a telephone subscriber to utilize a Web interface to establish distinctive ring tones for designated callers that are to be played as a "call waiting" signal. When one of the designated callers calls the telephone subscriber while the telephone subscriber is engaged in an existing call, the previously established ring tone associated with the designated caller will be played to the subscriber to help the subscriber identify the incoming caller. The telephone subscriber can then determine whether to accept the incoming call or not.

A. Cited Art fails to teach associating distinctive call waiting tones with incoming callers

In each independent claim, Applicants claim that distinctive call waiting tones associated with incoming callers are heard by the called party (the causing step of claim 1, the distinctive call waiting tone generator of claims 7 and 14, the providing and generating steps of claim 20). Epler fails to teach this limitation for which it is cited. Further, none of the other cited references cure this deficiency.

1. Epler fails to teach that distinctive call waiting tones are to be associated with incoming callers.

Epler teaches that an enhanced call waiting system can default to transferring an incoming caller to a messaging system, when a dialed line is busy. (Blocks 82 and 86 of FIG. 2) If a caller believes a call is urgent, they may override the default behavior and the called party will be presented with a call waiting prompt (column 6, lines 55-65). The call waiting prompt heard by the caller can indicate the level of urgency or importance established for the incoming call (Column 6, lines 14-20). The urgency indicating prompt is referred to as a distinctive call waiting tone. The urgency can be established based upon caller input as noted by column 6, lines 20-21 (*i.e.*, a telemarketer can be associated with a low urgency, a friend with a medium urgency, and a wife, a high urgency tone.)

Additionally, Epler teaches that a screening list can be established to permit certain callers to “override” the default behavior and establish an urgency level while callers not on the list will receive default behavior that cannot be overridden. For this reason, the urgency level can be based in part upon CPID (caller identity), as a caller “screened out” will only be permitted to utilize default behavior, while preferred callers will be allowed to establish an urgency level (column 6, lines 15-20). The screening list and behavior of it is shown in FIG. 4E, specifically in items 506, 508, and 510.

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The Examiner has interpreted Epler as teaching a technique for associating an urgency level with a caller's identity, meaning that automatic defaults can be placed in a table where certain callers will be associated with certain urgency levels. This technique is not present in the teachings of Epler and has been derived based on an impermissible use of hindsight in light of the Applicants' claimed invention.

Additionally, the Examiner has been confused by the term Distinctive Ringing and Distinctive Alerting as used and defined by Epler (column 5, lines 44-48 and column 5, lines 64-66). These functions refer to the situation where a subscriber can have multiple telephone numbers associated with a given line, each of these phones can distinctively ring depending upon the number called (column 6, lines 1-2). That is, I can have four phones each with a different number linked to the same lines. When you call me using one of the different numbers, one of the four phones will ring (using a distinctive "phone" ring.) This is reiterated by column 5, lines 44-48 where several numbers are assigned to a users' phone line, each of the several numbers producing differing indicators to the user through the Distinctive Alerting Feature.

Finally, the Examiner has been misled by the section of Epler relating to VIP codes. Presumably the Examiner believes that VIP codes somehow affect the urgency levels of column 6, lines 10-25.

Epler, however, fails to teach that VIP codes relate to urgency levels or different call waiting tones. In fact, as shown by FIG. 4B, item 220, VIP codes are one of four

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mutually exclusive screening options. The urgency levels apply to "standard screening option 1", as described through the specification. The mutually exclusive nature of VIP code screening and standard screening is shown by FIG. 4E (See items 512 and 530, noting they are different logic flows depending on the type of screening enabled.)

Additionally, the Examiner asserts that VIP screening inherently associates distinctive ring tones with calling parties. This is untrue. The VIP code is used to provide a party with the NAME of the person attempting to perform an incoming call, as shown by column 11, lines 47-53. This is also shown by item 614 of FIG 4F.

In summary, nowhere does Epler teach that a call waiting tone can be provided to a subscriber that is associated with the incoming caller (based upon a previously established association between the caller and the waiting tone). The urgency based call waiting tone described by Epler is different because it is a call based tone (not caller based one) that is established by caller input (not by a subscriber established association).

2. Other cited references fail to cure this deficiency of Epler.

In the various claims, the Examiner cites Fan, Mizikovsky, Kuechler, and Neil for their respective teachings. None of these references, however, teach that distinctive call waiting tones are to be associated with different incoming callers.

Fan is cited for teaching establishing different ring tones with different parties. This type of feature is common in mobile phones today. First, ring tones are different in nature and purpose from call waiting tones and practices adopted for ring tones would

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generally not apply to call waiting tones. For example, ringtones used in mobile phones to identify a caller using today's technologies are often songs, speech utterances, and the like, designed to obtrusively get a phone owners' attention. These obtrusive (and often annoying tones) would not be appropriate substitutes for call waiting tones, which are designed to unobtrusively let a phone owner know an incoming call is being attempted.

Second, Fan fails to teach associating distinctive ring tones with calling parties. Instead, Fan teaches that "the first internet telephone station 1 provides a distinctive ringing signal to a user" (column 8, lines 12-13). In Fan, a distinctive ring tone means a ring tone that permits a caller to know that an incoming call is an Internet call instead of a typical voice call. Calls between a standard telephone and an internet telephone station results in the internet telephone station ringing in a conventional manner, as noted by column 4, lines 8-15. Fan contains no teachings that distinctive ring tones are to be associated with callers. More importantly, Fan contains no teachings that call waiting tones are to be associated with different callers.

Mizikovsky, Kuechler, and Neil do not teach associating distinctive call waiting tones with callers, and have not been cited by the Examiner for such teachings.

Consequently neither Epler, Fan, Mizikovsky, Kuechler, Neil, or combinations thereof explicitly or implicitly teach the claimed limitation of associating a distinctive call waiting tone with a caller. Accordingly, the 35 U.S.C. § 103(a) rejections to claims

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1-26 based upon these references should be removed, which action is respectfully requested.

B. Cited Art fails to teach a Web based interface through which a subscriber can associate callers with distinctive call waiting tones.

In each independent claim, Applicants claim a Web enabled interface through which a subscriber can associate callers with distinctive call waiting tones (the providing step of claims 1 and 20 and the Web-enabled interface of claim 7 and 14). The cited references alone and in combination fail to teach or suggest this limitation.

1. Epler fails to teach a subscriber interface for establishing distinctive tones

The Examiner has cited interface 58 of Epler as being an interface through which the user can associate distinctive tones with callers. Epler contains no such teaching.

First, the Examiner has mistakenly confused hardware interface 58 with a user interface. Specifically, Epler includes a hardware interface 58 "for interacting the telephone lines 52 to the computer 56" from column 3, lines 46-47. The nature of interface 58 is further detailed at column 3, lines 52-55, which states "the telephone line interface 58 may be provided by cards which plug into the computer 56, such as model D41B interface cards manufactured by Dialogic (which is a hardware interface card)."

Additionally, Epler fails to teach that callers are associated with distinctive ring tones, as previously noted. At best, Epler teaches that callers can be associated with an urgency level tone (call based determined by caller input NOT caller based determined

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by caller identity in accordance with subscriber established tones), which is not the same nor does it serve the same purpose as associating a distinctive tones with specific callers.

2. Fan fails to teach a subscriber interface for establishing distinctive tones.

Fan is cited for teaching “a Web based interface through which the participant can associate distinctive ring tones with calling parties.” Fan provides no such teaching. Fan teaches that a distinctive ringtone can sound from an internet telephone station when a call is received from another internet telephone station (to distinguish from calls received from conventional telephones.)

Additionally, Fan does not teach that subscribers can select different call waiting tones via a Web-enabled interface with different callers, so that the selected call waiting tones are played when an incoming call is received by the caller. Fan is silent in regard to a Web based interface in general and it appears as though internet telephone is used for telephone calls conducted in a more or less conventional fashion (that can be VOIP calls as well as circuit switched calls). Regardless, the claimed Web-enabled interface is not taught or suggested by Fan.

3. Other cited references fail to cure this deficiency of Epler and/or Fan.

In the various claims, the Examiner cites Mizikovsky, Kuechler, and Neil for their respective teachings. None of these references, however teach an interface for permitting a telephone subscriber to establish distinctive call waiting tones for determining the identity of incoming callers.

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Consequently, even if the claim rejections are still asserted in spite of the early stated deficiencies, the claim rejections should be withdrawn on the basis that neither Epler, Fan, Mizikovsky, Kuechler, Neil, or combinations thereof explicitly or implicitly teach the claimed limitation of a Web based interface through which a subscriber can associate callers with distinctive call waiting tones. Accordingly and on this basis, the 35 U.S.C. § 103(a) rejections to claims 1-26 based upon these references should be removed, which action is respectfully requested.

The Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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